

REMARKS

The present Response is intended to be fully responsive to the objections and rejections raised in the outstanding Office Action mailed November 13, 2008 (the "Office Action"), and is believed to place the subject application in condition for allowance. Thus, favorable reconsideration and prompt allowance of the subject application is respectfully requested. Applicant does not acquiesce to any portion of the Office Action not particularly addressed herein.

Applicant notes with appreciation that all previous art-based rejections to claims 1-21 were withdrawn in light of the amendments and arguments advanced in the Request for Continued Examination filed on September 15, 2008. More particularly, the Examiner stated that "Applicant's arguments...have been fully considered and are persuasive. Therefore the previous rejections of claims 1-21 have been withdrawn." Paragraph 2 of the Office Action. The Examiner, however, advanced new art-based rejections under 35 U.S.C. §103(a) based in part on newly cited US Patent No. 7,262,880, to *Geissler et al.* (*Geissler*). These rejections are addressed by way of the current response.

In the Office Action, the following issues were raised:

- 1) Claims 1-4, 6, 8-14 and 21 were rejected as being allegedly obvious under 35 U.S.C. §103(a) over *Geissler* in view of previously cited US Patent No. 6,219,154 B1, to *Romano et al.* ("*Romano*").
- 2) Claims 5 and 15-20 were rejected as being allegedly obvious under 35 U.S.C. §103(a) over *Geissler* in view of *Romano*, and in further view of US Patent No. 6,429,947 to *Laverty et al.* (*Laverty*).
- 3) Claim 7 was rejected as being allegedly obvious under 35 U.S.C. §103(a) over *Geissler* in view of *Romano*, and in further view of US Patent No. 6,912,071 to *Rasmussen et al.* (*Rasmussen*).

In view of the following remarks, Applicant respectfully traverses each of the above rejections. Thus, Applicant submits that the subject application is in condition for allowance and respectfully requests that the Examiner so find.

I. CLAIM AMENDMENTS

By way of this response, Applicant amends each of claims 1 and 21 to ensure uniform use of the term "pre-printing stage" throughout the claims. Applicant respectfully submits that no new issues are raised by the foregoing amendments. Accordingly, prompt entry thereof is respectfully requested.

II. REJECTIONS TO CLAIMS 1-4, 6, 8-14 AND 21 UNDER 35 U.S.C. §103(a)

In the outstanding Office Action, the Examiner rejected claims 1-4, 6, 8-14 and 21 as being allegedly obvious over *Geissler* in view of *Romano*. In particular, with respect to independent claims 1 and 21, the Examiner summarized the teachings of *Geissler*, stating that:

Regarding Claims 1 and 21, *Geissler* discloses a printing process (see Fig. 1 (2,8) and Col. 2, Line 29-35) comprising: a pre-printing stage in which digital master image data are provided which represents an original master (see Fig. 1 (1,5) and Col. 7, Line 4-14), digital printing data for the printing colors involved in the printing that are produced from the master image data, which the digital printing data are transmitted to a print shop by way of a data channel for production in the print shop of printing plates by way of digital printing data (see Fig. 1 (2,6,8), Fig. 2 (24,26) and Col. 7, Line 62 - Col. 8, Line 1), the printing process further comprising the steps of:

- (a) producing test image data representing a test image by image wise colorimetric measurement of at least one printing sample by way of a color measurement (see Fig. 1 (2,7,8,9), Col. 7, Line 23-46 and Col. 8, Line 28-32), the test image being calculated from the digital printing data (see Fig. 1 (1,5), Col. 7, Line 7-14 and Col. 7, Line 37-44);
- (b) transmitting the test image data produced in the print shop to the pre-printing stage through a data channel (see Fig. 1 (1,2,6,7,8,9) and Col. 7, Line 34-43);
- (c) evaluating the test image data for quality monitoring (see Fig. 1 (3,10), Col. 7, Line 37-46 and Col. 8, Line 11-26);
- (d) transmitting the result of the quality monitoring through a data channel (see Fig. 1 (1,6,10,11)); and
- (e) using in the print shop the result of the quality monitoring transmitted from the quality monitoring stage in order to control the printing process (see Fig. 1 (1,2,4,6,8,11) and Col. 8, Line 28-32).

In the Office Action, the Examiner acknowledged that *Geissler* fails to disclose steps (f) and (g) of claims 1 and 21 ("*Geissler* fails to expressly disclose a repeat process for calibrating the color deviations between the master image data and the test image data when they are not in acceptable limits; and releasing the edition printing with the printing plates if color deviations between the master image data and the test image data are in acceptable limits;" Paragraph 6 of the Office Action). In an attempt to overcome these shortcomings, the Examiner referenced (without further explanation or application to the claim language) various teachings in *Geissler* and *Romano*. More particularly, the Examiner stated that *Geissler* "teaches controlling the printing process through quality monitoring (see Fig. 1 (1,2,4,6,8,11) and Col. 8, Line 28-32)." The Examiner further offered that "*Romano* teaches a method for calibrating digital plate setters or image setters (see Fig. 3, Fig. 7A and Col. 2, Line 48-55), in which test image data are used to confirm the acceptability of the image data (see Fig. 7A, Fig. 8 and Col. 13, Line 10-20)," and that "*Romano* further teaches that the quality of the recorded images can be continuously monitored and the plate/image setter can be automatically adjusted to ensure proper recording of the desired image (see Col. 8, Line 40-45 and Co. 13, Line 36-40)." On the basis of these teachings, the Examiner concluded that "[a]t the time of the invention, it would have been obvious for one skilled in the art to the steps to repeat [sic] the quality monitoring/color calibration process for the color deviations between the master image data and the test image data, and to release the edition printing with the printing plates when the master image data and the test image data are within acceptable limits."

In view of the following, Applicant respectfully submits that the Examiner failed to set forth a sustainable *prima facie* case in support of the present obviousness rejections to independent claims 1 and 21. As the Examiner is aware, the factual inquiries for establishing a *prima facie* case of obviousness under 35 U.S.C. §103 are set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). These factors include (1) determining the scope and content of the prior art, (2) ascertaining the differences between the prior art and the claims at issue, (3) resolving the level of ordinary skill in the pertinent art and (4) considering objective evidence present in the application indicating obviousness or nonobviousness.

Applicant respectfully submits that the Examiner failed to address all of the claim limitations recited in claims 1 and 21 of the subject application and, thus, failed to properly appreciate the full extent of the differences between the prior art and the claims at issue. More particularly, Applicant notes that the Examiner failed to address express claim limitations relating to edition printing.

Thus, with respect to claim 1 the Examiner failed to address:

- "an edition printing stage in which edition printing is carried out by way of these printing plates in a printing machine;"
- "producing test image data representing a test image by image wise colorimetric measurement of at least one edition printing sample;"
- "releasing edition printing with the printing plates if color deviations between the master image data and the test image data are in acceptable limit."

Similarly, with respect to claim 21 the Examiner failed to address:

- "[a] printing process involving two stages, a preprinting stage and an edition printing stage which comprises in the preprinting stage...producing printing plates in the print shop using the digital printing data for use in the edition printing to be carried out in a printing machine;"
- "using for the color control of the printing machine test image data corresponding to a test image produced by an image wise colorimetric measurement of at least one edition printing sample;"
- "releasing edition printing with the printing plates if the color deviations between the master image data and the test image data are in acceptable limits."

Applicant submits that the above claim limitations (relating to edition printing) are both material with respect to patentability and essential in the overall conceptualization of Applicant's claimed methods. More particularly, the above claim limitations describe an integral association between an edition printing stage and a pre-printing stage that advantageously translates to improved quality control. Thus, the methods of claims 1 and 21 clearly distinguish over conventional printer calibration and quality monitoring techniques *which are isolated from the edition printing process*. Indeed, as noted in the

previous responses (e.g., dated September 15, 2008 and April 15, 2008), each of "Applicant's claimed method[s] (i.e., independent claims 1 and 21) advantageously performs a quality monitoring check using the *actual image data for edition printing*." More particularly, the test image data is *calculated from the digital printing data* (i.e., the digital printing data is used to produce the printing plates which are used to produce at least one edition printing sample which is used to produce the test image data). Next, the test image data (representing the edition printing sample) is evaluated *in the pre-printing stage* for quality monitoring. Thus, as noted in the previous responses, the quality monitoring check is advantageously *optimized for the particular edition printing to be performed*. Therefore, once the color deviations between the master image data and the test image data are in acceptable limits, the edition printing is released. In this respect, claims 1 and 21 are drawn to methods for using test data *from an edition printing sample to optimize edition printing*.

Geissler, on the other hand, involves using data from one print job to update a printer's ICC profile, e.g., *for future unrelated print jobs*. Thus, it is noted that Geissler fails to disclose or make obvious using, *inter alia*, an edition printing sample for quality monitoring and printer calibration *in preparation for subsequent edition printing*. Indeed, Geissler teaches that "any desired original" may serve as a test form for calibrating a printing process. Column 7, lines 4-53. It is further noted that claims 1 and 21 of the subject application explicitly provide for quality monitoring as *part of the pre-printing process*. In contrast, Geissler performs quality monitoring (quality control stage 3) after the printing stage (printing stage 2), i.e., using a printed original. See, Figure 1 and column 2, lines 30-32.

Similarly, Applicant submits that *Romano* fails to disclose or make obvious the use of an edition printing sample to perform quality monitoring and printer calibration *for edition printing*. Rather, as noted in previous responses, *Romano* discloses using "a digital plate-setter or image setter control wedge formed by recording a *checkerboard pattern*, having a plurality of *checkerboard patches* (Col. 3, Line 25-30), to generate a color profile and/or perform calibration.

Thus, neither *Geissler* nor *Romano* -- whether taken alone or in combination -- disclose or make obvious the methods for optimizing and/or controlling edition printing

as providing in claims 1 and 21 of the subject application. Indeed, neither *Geissler* nor *Romano* so much as mention edition printing.

Applicant notes that "rejections on obviousness *cannot be sustained with mere conclusory statements*; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006). Accordingly, since various claim limitations in claims 1 and 21 were apparently disregarded in the outstanding Office Action, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case for obviousness. Furthermore, since such claim limitations are not disclosed or made obvious by the cited prior art, whether taken alone or in combination, Applicant respectfully submits that claims 1 and 21 patentably distinguish over the proposed prior art combination. Accordingly, Applicant requests reconsideration and withdrawal of the present obviousness rejections to independent claims 1 and 21.

Claims 2-4, 6 and 8-14 depend, either directly or indirectly, from claim 21 and recite additional features therefor. At least since the proposed combination of *Geissler* in view of *Romano* does not make obvious Applicant's invention as recited in independent claim 21, the proposed combination of *Geissler* and *Romano* also fails to render any of dependent claims 2-4, 6 or 8-14 obvious. Moreover, Applicant submits that each of the respective methods of dependent claims 2-4, 6 and 8-14 provides patentably distinct results that are not achieved and/or achievable with any variation of the proposed combination of *Geissler* and *Romano*. For at least the foregoing reasons, Applicant submits that each of the dependent claims presented herein is patentable over all the art of record, including specifically the proposed combination of *Geissler* and *Romano*. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the present obviousness rejections to dependent claims 2-4, 6 and 8-14.

IV. REJECTIONS TO CLAIMS 5 AND 15-20 UNDER 35 U.S.C. §103(a)

As noted above, claims 5 and 15-20 currently stand rejected as allegedly obvious over *Geissler* in view of *Romano* and in further view of *Laverly*. These rejections are respectfully traversed.

As previously discussed, the factual inquiries for establishing a *prima facie* case of obviousness under 35 U.S.C. §103 include (1) determining the scope and contents of the prior art, (2) ascertaining the differences between the prior art and the claims at issue, (3) resolving the level of ordinary skill in the pertinent art and (4) considering objective evidence present in the application indicating obviousness or nonobviousness. Here, a *prima facie* case of obviousness has not been established, at least because independent claim 21, from which claims 5 and 15-20 depend, includes limitations which are not disclosed or made obvious by *Geissler*, *Romano* and/or *Lavery*, whether taken alone or in combination.

In discussing the teachings of *Lavery*, the Examiner focused on the respective limitations of dependent claims 5 and 15-20. However, as is readily apparent, *Lavery* fails to address and/or cure the deficiencies noted above with respect to independent claim 21 (from which claims 5 and 15-20 depend). Applicant respectfully submits that *Lavery* fails to teach or suggest, *inter alia*, a modification to the teachings of *Geissler* and/or *Romano* that would render obvious independent claim 21. As such, a *prima facie* case of obviousness has not been established because the combination of the cited references fails to yield a method that includes all of the limitations recited in independent claim 21. Accordingly, Applicant respectfully submits that claims 5 and 15-20 patentably distinguish over the proposed combination of *Geissler*, *Romano* and *Lavery* for at least the reasons noted herein with respect to independent claim 21. Applicant respectfully requests that the present obviousness rejections of claims 5 and 15-20 be reconsidered and withdrawn, and the claims allowed.

IV. REJECTION TO CLAIM 7 UNDER 35 U.S.C. §103(a)

The Examiner rejected claim 7 as allegedly obvious over *Geissler* in view of *Romano* and in further view of *Rasmussen*. This rejection is respectfully traversed.

Claim 7 depends from independent claim 21 and recites additional features therefor. At least since the subject matter of independent claim 21 is not obvious in view of the proposed combination of *Geissler*, *Romano* and *Rasmussen*, the subject matter of claim 7 is similarly not obvious in view thereof. Accordingly, Applicant respectfully submits that claim 7 is patentable over all the art of record, including

specifically the proposed combination of *Geissler, Romano* and *Rasmussen*. Applicant respectfully requests that the present obviousness rejection to claim 7 be withdrawn, and the claim allowed.

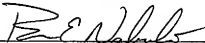
CONCLUSION

For at least the foregoing reasons, Applicant submits that the issues leading to the present rejections of claims 1-21 have been fully and completely addressed, and that none of the claims presently in the application is obvious under the provisions of 35 U.S.C. §103. Consequently, Applicant believes that each of these claims is presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Office believes that any unresolved issues still exist or if, in the opinion of the Office, a telephone conference would expedite passing the present application to issue, the Office is invited to call the undersigned attorney directly at 203-399-5920 or the office of the undersigned attorney at 203-399-5900 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Date: February 12, 2009



Basam E. Nabulsi
Reg. No. 31,645
Attorney for Applicant

MCCARTER & ENGLISH LLP
Financial Centre, Suite 304A
695 East Main Street
Stamford, CT 06901-2138
203-399-5920
203-399-5820 (fax)
bnabulsi@mccarter.com